

### **REMARKS/ARGUMENTS**

Claims 1 to 8 and 19 to 30 remain in this application. Claims 9 to 18 have been canceled, without prejudice, to filing in a continuing application.

Claims 1, 4, 7, 19, 21, 22, 26 and 27 were previously amended.

The Examiner maintains her rejection of claims 1, 6 and 19 as being anticipated by Drout et al. US Patent No. 5,084,501. However, not all of the limitations of independent claims 1 and 19 are disclosed in Drout et al.

Claims 1 and 19 require “the portion of the second layer adjacent the exposed surface [to] compris[e] substantially all transparent or translucent particles.” In Drout et al. the

“filler particles were coated with the liquid components and then a dispersion grade PVC resin was blended with the coated filler particles. By this means, the relatively small, less than 15 micron resin particles would coat or adhere to the surface of the relatively large filler particles.”

Column 3, lines 40 to 48. Since the resin particles adhere to the surface of the filler particles in Drout et al., both the resin particles and filler particles are distributed throughout the Drout et al. structure. The portion of the Drout et al. layer adjacent the exposed surface, when the composition is laid up, does not comprise substantially all transparent or translucent particles since these particles are adhered to the filler particles. As stated at column 2, lines 52 and 53, of Drout et al.:

“It has been found that a uniform distribution of PVC resin and filler can be obtained even at high filler content.

Therefore, the relatively large filler particles, which the Examiner states “resemble the pigmented particles,” are distributed throughout the Drout et al. composition and Drout et

al. does not teach a layer having portion adjacent an exposed surface comprising substantially all transparent or translucent particles, as required by independent claims 1 and 19.

The Examiner takes the position that column 3, line 6, to column 4, line 7, of Drout et al. clearly shows the particles of the two kinds are not uniformly distributed. The Examiner's position is not well founded. Specifically, see column 3, lines 23 to 25, where Drout et al. state:

“By adhering the resin particles to the surface of the filler particles, a uniform distribution is maintained.”

And column 3, lines 40 to 42, where they state:

“It has been found that by modifying the mixing procedure, a highly filled composition could be obtained which retained its uniform distribution.”

(Emphasis supplied.) Clearly, the invention of Drout et al. is a structure in which the filler and resin particles are uniformly distributed. Therefore, independent claims 1 and 19, which require a portion of the second layer adjacent the exposed surface to comprise substantially all transparent or translucent particles, are not anticipated by Drout et al.

Again, independent claims 1 and 19 require the pigmented particles to comprise a majority by volume of the first layer and a portion of the second layer adjacent the exposed surface to comprise substantially all transparent or translucent particles. Therefore, a uniform distribution of the pigmented particles and transparent or translucent particles, as taught by Drout et al. does not meet the limitations of claims 1 and 19.

At column 3, lines 25 to 39, Drout et al. discuss an embodiment that falls outside their invention and the prior art. While the Examiner is correct that this passage describes structures in which the two particles are not uniformly distributed, it does not

teach or suggest two layers, one that has a majority of filler particles and one that has a portion adjacent the exposed surface that is substantially all resin particles. This section of Drout et al. states:

If the resin particles are relatively large compared to the filler particles, the resin particles will not adhere to or coat the filler particles and the filler particles would tend to concentrate at the bottom of the resin composition.

The procedure of the prior art was to blend the liquid components of the resin composition, such as plasticizers and stabilizers, with the PVC resin. The liquid components would be absorbed into the resin components. Then the filler would be blended into the mixture. Since the liquid components were absorbed into the filler particles, the composition would retain its dry flowable powder characteristics. However, the heavier filler particles would tend to settle at the bottom of the composition.”

(Emphasis supplied.) As stated above, the filler and resin particles are blended into a mixture. The intent in both Drout et al. and the prior art is to obtain one layer of uniformly distributed particles, not two layers of different particles. In even the prior art structure, the “heavier filler particles would tend to settle at the bottom.” While the distribution may not be the desired uniform distribution, clearly two layers are not formed. More particularly, while the filler particles may tend to settle, there is no teaching or suggestion of a portion adjacent the exposed surface being substantially all resin particles, as required by claims 1 and 19.

As defined in Webster’s Third New International Dictionary of the English Language Unabridged, 1971 at page 2354, “tend” means “2a: to have an inclination to a particular quality, aspect, or state ... 3: to exert activity or influence in a particular direction.” While the heavy filler particles of the prior art may have an inclination to form a layer on the bottom and gravity exerts a force to influence the filler particles to the bottom, it is incorrect to hold that such a layer is formed. If such a layer were formed, it

would be incorrect to state that the filler particles tend to settle to the bottom. There would be no “tending”, the filler particles would have settled to the bottom. Therefore, independent claims 1 and 19 are not anticipated by Drout et al.

Claim 6 depends on claim 1. Therefore, claim 6 is not anticipated by Drout et al.

Further, independent claims 1, 19, 21 and 36 are directed to a welding rod or a surface covering having a seam formed from a welding rod and at least two sheets. The Court of Appeals for the Federal Circuit has stated that”

“clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.”

(*Catalina Mktg. Int’l Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808-809, 62 USPQ2d 1781, 1785 (2002).) Therefore, “weld rod” is a claim limitation. Drout et al. is directed to a “resin composition ... intended for use in the manufacture of resilient flooring” (column 3, lines 49 and 50). There is no teaching or suggestion to use the Drout et al. composition as a welding rod. The Balmer Declaration, filed with the last Response, establishes that the highly filled resin composition of Drout et al. cannot be used to form a welding rod. Therefore, independent claims 1, 19, 26 and 21 are neither anticipated nor obvious in view of Drout et al. for this reason as well.

The Examiner maintains her rejection of claims 1 to 8 and 19 to 30, all of the claims remaining in the application, as being obvious over Drout et al. in view Lussi et al. US Patent No. 5,290,591. The Examiner states, in the second paragraph of section 2 on page 3 of the Final Office Action, “The powdered highly filled PVC resin is comprised of a larger size filler particles (as a bottom layer) and a smaller size PVC resin particles as a

surface layer” citing column 3, lines 37 to 39 and 42 to 47, of Drout et al. However, Drout et al. does not teach two layers of different sized particles. See the discussion above.

If the Examiner maintains her position that Drout et al. teaches two layers of different particles, she is requested to point specifically to the passage in Drout et al. and explain how such passage teaches two layers, including a layer having a portion that is adjacent the exposed surface and comprising substantially all transparent or translucent particles. Attorney for Applicants maintains that Drout et al. teaches that in the prior art embodiment the heavier filler particles merely tend to settle to the bottom. Those of ordinary skill in the art desired the filler and resin particles to be uniformly distributed. While they may not have achieved uniform distribution, they were able to prevent two distinct layers from forming.

One of ordinary skill in the art would mix the highly filled resin composition of the prior art shortly prior to forming and processing the flooring structure to obtain as uniform distribution of particles as possible. Drout et al. and the reference in Drout et al. to the prior art teach away from the present invention.

Near the middle of page 4 of the Office Action, the Examiner states “In view of the prior art teachings, one skill [sic] in the art would fabricate a three dimensional thermoplastic rod that comprised of pigment particles layers [sic] as the lower layer and transparent or translucent particles layer over the ‘decorated’ layer because transparent or translucent cover layer allows the ‘decoration’ to show through and to give a protection to the bottom layer.”

It is not apparent how Drout et al. has been combined with Lussi et al. Drout et al. teach a highly filled PVC resin powder which is formed by coating filler particles with a liquid and blending a dispersion grade PVC resin with the coated filler particles to obtain uniform distribution of the resin and filler. Abstract and column 2, lines 52 to 56. Lussi et al. teach a decorative inlaid floor or wall covering product comprising a substrate on which a pattern or design is printed, the printed substrate underlying an adhesive layer in which transparent and/or translucent PVC particle are embedded. Column 3, lines 48 to 58; column 5, lines 5 and 6; and column 10, lines 29 to 31.

The Examiner does not explain how the teachings of Lussi et al. are combined with the teachings of Drout et al. to obtain the claimed invention. Further, neither Drout et al. nor Lussi et al. teach or suggest a weld rod structure.

The Examiner fails to explain how one of ordinary skill in the art would be led by Drout et al. and Lussi et al. to fabricate a thermoplastic rod. Neither reference teaches making a weld rod or even a rod. In fact, as supported by the Balmer affidavit, the Drout et al. composition has insufficient strength to form a rod.

It is not evident how the combination of Drout et al. and Lussi et al. teach or suggest a lower layer of pigmented particles and a transparent or translucent particles layer over the 'decorated' (presumably lower) layer. Both Drout et al. and Lussi et al. teach a composition comprising pigmented particles and transparent and/or translucent particles. There is no teaching or suggestion in either Drout et al. or Lussi et al. to form two layers, one of pigmented particles and one of transparent and/or translucent particles. If the Examiner disagrees, she is respectfully requested to point out in the references where such teaching or suggestion occurs.

Lussi et al. further teaches applying an adhesive layer to a printed layer and embedding the composition of pigmented and transparent and/or translucent particles into the adhesive layer. If it is the Examiner's position that the Lussi et al. print layer is the lower, decorated layer, Lussi et al. teaches drying the print layer before applying the adhesive layer. See Lussi et al. column 14, lines 53 to 55, and column 16, lines 25 to 27. In fact, the particles are applied over the adhesive layer and then embedded into the adhesive layer. See column 10, line 37; and column 14, lines 53 to 61. Therefore, the suggested structure lacks the limitation of the present independent claims that "particles of the second layer fill[] at least some of the voids between particles of the first layer, whereby the second layer penetrates into the first layer at the interface between the first and second layers."

Neither the pigmented particles of the Drout et al. nor Lussi et al. are applied to for a design or pattern. Both are randomly applied. Therefore, claim 3 is patentable over Drout et al. in view of Lussi et al.

Applicants maintain that the claims are in condition for allowance. Therefore, they respectfully request that a timely Notice of Allowance be issued in the application.

Respectfully submitted,

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